

Serial No.: 10/607,252
Docket No.: SO0023 US NA

Page 6

REMARKS

Explanation of Amendments/Restriction Requirement

As can be seen from above, claim 29-34 and 37 have been canceled in conjunction with restriction requirement of record in this application. This cancellation is made without prejudice of any sort to pursue the canceled claims/subject matter in one or more continuing/divisional applications.

Allowable Subject Matter

The Applicants gratefully acknowledge the indication in the aforementioned Office Action of the allowability of the subject matter of current claims 2, 4, 9, 10, 11, 15-17 and 35-36.

The Applicants, however, respectfully contend that the full claimed subject matter of this application is patentable over the cited art for the reasons set forth below.

Note on Information Disclosure Statement

While the Applicants believe that the required copies of the references were in fact submitted, the Applicants are re-submitting those references for consideration by the Examiner in a supplemental information disclosure statement.

Rejections

(i) Anticipation

Claims 1, 7, 8, 12, 18, 21-23 and 27-28 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by the disclosure of JP2000-239927 (the '927 reference). The Applicants respectfully traverse this rejection.

As is well established, anticipation requires the disclosure in a single prior art reference of each and every element of a claimed invention arranged as set forth in the claim. It is thus not sufficient for anticipation purposes for a prior art reference to simply disclose the various elements - the disclosure must show those elements arranged in a manner identical to the arrangement set forth in the claims. The Appli-

Serial No.: 10/607,252
Docket No.: SO0023 US NA

Page 7

cants submit that the disclosure of the '927 reference does not meet this standard.

As set forth in independent claim 1, the presently claimed subject matter is directed to a process for preparing a poly(trimethylene terephthalate) ("PTT") bicomponent fiber, the process comprising the following steps:

- (a) providing two PTT melts,
- (b) altering the intrinsic viscosity ("IV") of at least one of said polymers such that after alteration, said polymers have intrinsic viscosities that differ by at least about 0.03 dL/g;
- (c) providing the two PTT melts to a spinnerette, and
- (d) spinning bicomponent fiber from the PTT melts.

Admittedly, the '927 reference does appear to disclose the spinning, via a spinnerette, of a bicomponent fiber from two PTT melts of differing IVs. The Examiner contends that the '927 reference further discloses in paragraph [0014] the step of "altering/adjusting" the IVs of the PTTs prior to spinning, thus disclosing step (b) above. The Applicants, however, submit that a fair and consistent reading of the translation does not in fact support this interpretation.

As correctly pointed out by the Examiner, paragraph [0014] of the translation of the '927 reference literally includes the following statement:

"For a method to form crimp of no less than 30%, a method to adjust the limiting viscosity difference between two polyesters is preferable."

Paragraph [0014] immediately goes on to further state:

"And in order to make the crimp of the composite fiber 30% or higher preferable is to use a polyester having the limiting viscosity of 0.6-1.10 for the low limiting viscosity side, and a polyester having the limiting viscosity of 0.7-1.30 for the high limiting viscosity side, and to combine them so as to form a limiting viscosity difference of no less than 0.1 between two polyesters."

The clear implication of this language, and the rest of the disclosure of the '927 reference, is that the "method of ad-

Serial No.: 10/607,252
Docket No.: SO0023 US NA

Page 8

justing" referred to in Paragraph [0014] is merely the selection of two polyesters having different IVs for use in the process. This is not "altering" the IV of at least one of the polymers in the course of the process as required by the present claims.

Further support for this limited interpretation of paragraph [0014] can be found in paragraph [0016], where it is stated:

"Next, a preparative method for the composite of the present invention is described. First, two types of polyesters having mutually different limiting viscosities are melted with the composite spinning equipment, measured at separate measuring holes, allowed to combine at the back of the nozzle so as to form the side-by-side type and discharged at the spinning temperature of 240-290°C from the same discharging hole, and the spun yarn is cooled."

This is exactly the process used in the examples of the '927 reference - no "altering" of the IV is done after selection of the polyesters. There simply is no disclosure of in-process altering as required by the present claims, much less any disclosure of even how to in-process alter.

The Examiner's extension of the language "adjusting" from the '927 reference to include "altering" as in the context of the present invention is thus clearly not supported by the present record. The fair and supportable disclosure of the '927 reference, therefore, does not disclose each and every limitation of the present claims, and does not anticipate the present claims. In view of this, the Applicants respectfully request withdrawal of the anticipation rejection.

(ii) Obviousness

Claims 3, 5, 6, 13, 14, 19, 20 and 25-26 stand rejected under 35 U.S.C. §102(a) as allegedly being unpatentable over the disclosure of the '927 reference in view of "applicant's admitted prior art". In view of the novelty of claims 1, 7, 8, 12, 18, 21-23 and 27-28 as discussed above, the Applicants re-

Serial No.: 10/607,252
Docket No.: SO0023 US NA

Page 9

spectfully traverse this rejection as applied to all the claims of this application.

As detailed above, the '927 reference does not disclose the step of altering the IV of at least one of the polymers in the course of the process as required by the present claims.

As a consequence, in order to support an obviousness rejection based on the disclosure of the '927 reference, there must exist some supportable reason, suggestion or motivation which would lead the person of ordinary skill in the art to modify the disclosure of the '927 reference in the manner required to arrive at the presently claimed invention. The Applicants submit that the required reason, suggestion or motivation does not exist.

The Applicants do admit, as indicated by the Examiner, that it is known to alter the IV of PTT via various means. What is not known, and what is required by the present claims, is to alter the IV of at least one of the PTTs in the course of the spinning process.

The mere fact that the prior art could be so modified does not make the modification obvious unless the prior art suggests the desirability of the modification. Such desirability, much less any reason, suggestion or motivation to modify the disclosure of the '927 reference as required to arrive at the presently claimed invention, is nowhere to be found in the disclosure of the '927 reference or the present record, and simply does not exist in fact.

In other words, a key element required to support an obviousness rejection is missing from the Examiner's grounds - the necessary reason, suggestion or motivation. It is the Applicants' position that such reason, suggestion or motivation does not exist. In fact, the only way to arrive at the presently claimed invention from the disclosure of the '927 reference is with hindsight benefit of the Applicants' disclosure and claims. Hindsight, however, is an inappropriate perspective in which to judge patentability.

The Applicants thus respectfully submit that the Examiner has not substantiated this obviousness rejection based on the

Serial No.: 10/607,252
Docket No.: SO0023 US NA

Page 10

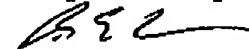
disclosure of the '927 reference, alone or in conjunction with "applicant's admitted prior art", and request withdrawal of the rejection as applied to the claims of this application.

Conclusion

In view of the amendments and arguments presented above, the Applicants submit that claims 1-28, 35 and 36 are patentable over the art of record, and that this case is otherwise in condition for allowance.

Should the Examiner wish to discuss any issues involved in this application, the Examiner is respectfully invited to contact the undersigned at the telephone exchange set forth below.

Respectfully submitted,



BART E. LERMAN
ATTORNEY FOR APPLICANTS
REGISTRATION NO. 31,897
TELEPHONE: 302-992-5285
FACSIMILE: 302-992-5374

Dated: 2/17/06